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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,016	12/30/1998	SCOTT L. MINNEMAN	100126	2341

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OLIFF & BERRIDGE
P O BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

CHIEU, PO LIN

ART UNIT PAPER NUMBER

2615

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,016

Applicant(s)

MINNEMAN ET AL.

Examiner

Polin Chieu

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/20/04 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4, 6, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al (5,974,219) in view of Guy et al (5,883,468) and Russo et al (5,701,383).

Regarding claim 1-2 and 4, Fujita et al discloses an indexing device that indexes recordings of activity based on a user input (col. 11, lines 54-61); an object description file that stores at least one index (fig. 16, col. 27, lines 7-33); a user input device that selects at least one item of the at least one index (col. 12, lines 1-8); and a association device that associates the selected at least one item with the recording of an activity (fig. 16); and further comprising a recording system that records the activity (323, fig. 3); and an audio/video storage device that stores a recorded activity (col. 8, lines 18-36). However, Fujita et al does not disclose that the input is at least one input capable of receiving or conveying information between a user and the system, other than at least one audio/visual recorder input or a recording device located internal to a presentation device; and a playback system for replaying an indexed recording that allows simultaneous recording of an activity while replaying an indexed recording.

Guy et al teaches that the input is at least one input capable of receiving or conveying information between a user and the system, other than at least one audio/visual recorder input or a recording device located internal to a presentation device (col. 4, lines 40-60).

Russo et al teaches a playback system that allows replaying of an indexed recording while simultaneously recording an activity to an audio/video storage device (col. 4, lines 1-43). Russo et al teaches that the device is able to continuously record incoming video while "time-shifting" video. For example, a user is able to view five minutes back into recorded video while the video signal is still being recorded (VCRs

would require the user to wait until recording is complete to view previously recorded video data).

It would have been highly desirable to allow playback of an index while simultaneously recording an activity so that the user does not have to wait until recording is complete to view the recorded data. It would have been highly desirable to have the at least one input capable of receiving or conveying information between a user and the system, other than at least one audio/visual recorder input or a recording device located internal to a presentation device so that the video data could be sent to other people not located near the device.

Therefore, it would have been obvious to a person of ordinary skill in the art the time of the invention to have an input capable of receiving or conveying information between a user and the system; and to allow playback of an index while recording in the device of Fujita et al.

Regarding claims 6, Fujita et al discloses a playback system for replaying an indexed recording, wherein the playback system can replay a portion of the indexed recording in response to selecting an item from the index (col. 24, line 20 – col. 25, line 11).

Regarding claims 8-9, Fujita et al discloses displaying at least one of the at least one index, the at least one item and the recording (fig. 15); and wherein the association device temporally associates the recording of an activity with the selected at least one item.

5. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al in view of Guy et al, Russo et al, and Mincy et al (6,052,508).

Regarding claims 3 and 7, Fujita et al does not disclose an editing system that allows a recorded activity to be inserted into a current recording.

Mincy et al teaches an editing system that allows a recorded activity to be inserted into a current recording (col. 22, lines 50-59).

It would have been highly desirable to have an editing device allowing insertion of a previous recording into a current recording so that a desired video output can be produced.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have an editing system that allows a previous recording to be inserted into a current recording in the device of Fujita et al.

6. Claims 10-11, 13, 15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al in view of Aotake (6,385,386).

Regarding claims 10-11 and 13, Fujita et al discloses indexing recording activity based on a user input; storing at least one index; selecting at least one item of the at least one index based on a user input; recording an activity; associating the selected at least one item with the recorded item; using a recording system to record the activity; and storing a recorded activity in an audio/video storage device (as discussed in the art rejection of claims 1-2 and 4). However, Fujita et al does not disclose monitoring the at least one index and indicating when the at least one item has begun recording; and

replaying an indexed recording with a playback system while simultaneously recording an activity.

Aotake teaches monitoring the at least one index and indicating when the at least one item has begun recording (col. 22, lines 27-60); and replaying an indexed recording with a playback system while simultaneously recording an activity (col. 34, lines 8-20).

It would have been highly desirable to indicate when recording has begun so that the user can determine the status of the recorder. It would have been highly desirable to allow playback while simultaneously recording to provide more convenience to the user (col. 33, line 66 – col. 34, line 7).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to monitor the at least one index and indicating when the at least one item has begun recording; and replay an indexed recording with a playback system while simultaneously recording an activity in the device of Fujita et al.

The limitations of claim 15 were discussed in the art rejection of claim 6. Please refer to the art rejection of claim 6.

The limitations of claims 17-18 were discussed in the art rejection of claims 8-9. Please refer to the art rejection of claims 8-9.

Regarding claims 19-21, Fujita et al discloses recording audio, video, and multimedia (1702, fig. 17).

7. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al in view of Aotake and Mincy et al.

The limitations of claims 12 and 16 were discussed in the art rejection of claims 3 and 7. Please refer to the art rejection of claims 3 and 7.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al in view of Aotake and Guy et al.

The limitations of claim 22 were discussed in the art rejection of claim 1. Please refer to the art rejection of claim 1.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakagawa et al, Chiu et al, and Wadahama et al disclose various devices used for lecturing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Polin Chieu whose telephone number is (703) 308-6070. The examiner can normally be reached on M-Th 8:00 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

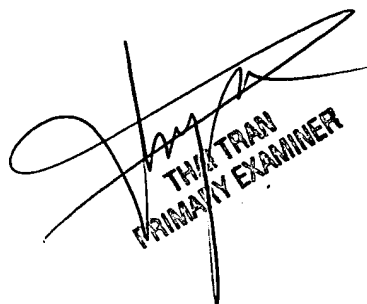
Washington, D.C. 20231

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PC
March 17, 2004



THI TRAN
PRIMARY EXAMINER